

**REMARKS**

Claims 1 through 7 and 18 through 22 are pending in this application. In response to the final Office Action dated April 25, 2006, claims 1, 3, 7, 19, and 21 have been amended to correct minor informalities noted in the Office Action under 35 U.S.C. §112, second paragraph. Entry of these amendments is proper under 37 C.F.R. 1.116(b)(1), as they merely reflect wording changes without modification of the scope of the claims, and raise no issues that would require additional substantive examination. The Applicants respectfully request reconsideration of the application in light of the following comments.

**I. Rejections Under 35 U.S.C. §102(b)**

In Section 5 of the Office Action, claims 1 and 7 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2001/0037383 (hereinafter “Sabal”). Applicants respectfully traverse.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987) (cited in MPEP §2131). The Office Action fails to identify, and the Applicants are unable to find, disclosure by Sabal of all of the elements recited and required by the claims. Therefore, the asserted anticipation under 35 U.S.C. §102(b) cannot be sustained by the teachings of Sabal.

**A. Claim 1**

Claim 1 recites the “verification of a required user qualification, wherein the required user qualification is a minimum credit rating for a user.” The Office Action implies, but is not explicit with respect to this limitation, that somehow the “room number, terminal number, service type, service period, credit card number and/or credit card expiration date information”

taught in paragraph 20 of Sabal is said to fulfill the “minimum credit rating for a user” limitation recited in claim 1. At most, this set of data provides the user’s credit card information. Such credit *card* information is readily distinguished from the credit *rating* recited in claim 1.

The present application describes how and why a credit rating, rather than credit card information, might be employed. Paragraph 34 describes “extend[ing] credit for network usage commensurate with the user’s credit rating” as an advantage over the prior art. Paragraph 13 further notes that “because network access is provided without a credit card, the network service provider is essentially extending credit to each of its users. . . . Treating all users similarly despite past credit performance might not be the most beneficial route.”

The credit rating limitation has been cited frequently throughout the prosecution of this application to distinguish the claims over the prior art. In the March 8, 2004 Petition to Make Special, each of the 21 pre-examination search references is distinguished from the claims for failing to “disclose or suggest verification of a user qualification based on the user’s credit rating.” For example, on page 7 it is noted that “[a]lthough [the prior art reference] discusses [the] use of remote sites, such as banking institutions and credit bureaus, these sites are used to validate credit and/or debit cards. [The reference] does not disclose or suggest a qualification verification device that verifies a user qualification based on the user’s rating.” As in the reference discussed in the previous quotation, the Sabal process also merely validates a user’s credit card, apparently by charging the transaction to the card, rather than making use of the user’s credit rating as claimed.

The limitation was also cited in the Amendment of February 3, 2006, to distinguish the claims from Skantze:

... Skantze appears to be configured for--and directed to--providing immediate payment from a payment provider.

**Skantze differs distinctly from the present claims in that it does not permit delayed payment based on an extension of credit due to a user's credit rating.** Such delayed payment is permitted by the system of the present disclosure. In fact, Skantze teaches away from delayed payment. More particularly, Skantze provides as follows: "A problem ... is, however, how the service provider is to receive payment from the customer. One possibility is, of course, for the service provider to send an invoice to the person placing the order on the basis of information that the person placing the order has filled in the advertisement. This is, however, in many cases an expensive method in relation to the cost of the service. In addition, there is the risk that the service provider will not be paid by the person placing the order." [See para. 005 of Skantze] Accordingly, because Skantze teaches away from delayed payment based on a user credit rating, this limitation is not even suggested by Skantze.

(Feb. 3, 2006 Response, pp. 10-11)

Sabal is similarly not directed toward permitting delayed payment. Instead, it specifically secures payment from, rather than extends credit to, a user prior to permitting Internet access. The series of steps surrounding the credit validation billing process (numerals 180 and 630) do not differ materially from a standard credit card purchase transaction. There is no teaching or suggestion whereby the Sabal process employs the user's credit *rating* as a qualification – only the user's credit *card*. Instead, Sabal teaches the following:

- calculating the full amount to be charged for the requested Internet access (*see ¶ 20 ("request . . . service type, service period . . ." from which cost is determined); ¶¶ 31-32 (user presented with list of durations and associated prices to choose from); Figure 3 (database entry including selected service (345) and cost (350)))*,
- charging said amount to the customer's credit card (*see ¶ 40 ("the method 180' accepts . . . the amount of the charge"); Figure 9, numeral 930 (user provides credit card number and expiration date); Figure 9, numeral 940 (transmitting "request (credit card #, expiration date, amount)" to credit card verification billing process 180))*),
- in advance of enabling access to the Internet.

So long as the credit card company accepts the charge (Figure 9, numeral 950 ("response (approve/deny)" for credit card transaction), the user will be granted access. None of these process elements involve qualification based on a user's credit rating, as claimed.

**B. Claim 7**

The same discussion of the rejection of claim 1 under 35 U.S.C. §102(b) applies to claim 7, as it contains the same limitation of “a required user qualification . . . wherein the required user qualification is a minimum credit rating for a user.” The Applicants respectfully traverse the rejection of claim 7 for at least the same reasons as claim 1.

Furthermore, the Office Action misquotes the language of claim 7, and thus seeks to apply the teachings of Sabal to elements not recited in the claim, while failing to address other recited limitations. It appears that the final paragraph of the rejection of claim 7 under 35 U.S.C. §102(b) (starting on page 4 of the Office Action) is a simple duplication of the final paragraph of the rejection of claim 1. This duplicated portion does not apply to claim 7, as claim 7 recites a different set of limitations than those recited in claim 1. The rejection of claim 7 cites a “gateway device” that is not recited in claim 7. Additionally, it omits the limitations that “the required user qualification is a minimum credit rating for a user” and that “the user qualification input signal includes a second unique user identifier.” The Applicants do not find such limitations disclosed by Sabal, and the Office Action acknowledges that “Sabal does not expressly teach that the user qualification input signal includes a second unique user identifier” (¶ 7). Since it does not teach all of the limitations recited by the claim, Sabal does not anticipate claim 7 under 35 U.S.C. §102(b).

**II. Rejections Under 35 U.S.C §103(a)**

In order to establish a *prima facie* case of obviousness, the prior art references must, individually or in combination, teach or suggest all of the limitations of the claims (see MPEP §2142). As discussed above, the independent claims 1 and 7 of this application are not anticipated by Sabal for lack of teaching or suggesting all of the recited limitations. The

additional references cited in the rejections under 35 U.S.C. §103(a) do not repair this critical shortcoming of the Sabal reference.

**A. Claim 7**

In Section 7 of the Office Action, claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal. The Applicants respectfully traverse this rejection.

The rejection of claim 7 under 35 U.S.C. §103(a) repeats the erroneous duplication also presented in the rejection of claim 7 under 35 U.S.C. §102(b) (see earlier discussion of claim 7, previous page), and similarly fails to address the limitation that “the required user qualification is a minimum credit rating for a user.” As discussed, Sabal does not teach or suggest such a limitation, and therefore cannot support a *prima facie* case of obviousness.

In a subsequent paragraph, the Office Action acknowledges that “Sabal does not expressly teach that the user qualification input signal includes a second unique user identifier,” but proceeds to ignore the recited limitation as “nonfunctional descriptive material.” The previous Office Action of August 5, 2005, also alleged that similar limitations were nonfunctional descriptive material (*see* Aug. 5 2005 Office Action, ¶¶ 23-24 and ¶¶ 13-16 (claim 1)). Applicants’ subsequent response specifically addressed this basis of rejection, pointing out that the recited elements “react[] in a set manner to a specific form of input” (*see* Feb. 3 2006 Response, p. 10, *see also* pp. 8-9 (including detailed discussion of *In re Gulack* case cited by Office Action). The current Office Action does not respond to this argument, as it deems all of the arguments of the response “moot in view of the new ground(s) of rejections” primarily based upon the Sabal reference. The same arguments presented in Applicants’ prior response applies to this limitation as well. A functional relationship exists between the second unique user identifier and the qualification verification device. The qualification verification device operates

based upon a specific form of input, which includes the recited second unique user identifier. As the Office Action acknowledges that Sabal does not teach this required element, the reference lacks another element needed to sustain a *prima facie* case of obviousness.

**B. Claims 2-6 and 18-22**

In Section 5 of the Office Action, claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal (as applied to claim 1 in its 35 U.S.C. §102(b) rejection) in view of U.S. Patent No. 6,965,865 (hereinafter “Pletz”). As noted above, Sabal does not teach or suggest all of the limitations of the parent claim 1. Pletz also does not teach or suggest the recited “required user qualification, wherein the required user qualification is a minimum credit rating for a user” limitation. Neither of the two references, taken alone or in combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

The last two paragraphs of Section 5 of the Office Action imply that the Examiner considers claims 3 and 4 rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal in view of Pletz. For the same reasons discussed above for claim 2, neither of the two references, taken alone or in combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

In Section 6 of the Office Action, claims 5 and 6 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal (as applied to claim 1 in its 35 U.S.C. §102(b) rejection) in view of U.S. Patent Application Publication No. 2004/0226459 (hereinafter “Hill”). As noted above, Sabal does not teach or suggest all of the limitations of the parent claim 1. Hill also does not teach or suggest the recited “required user qualification, wherein the required user qualification is a minimum credit rating for a user” limitation. Neither of the two references, taken alone or in

combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

In Section 7 of the Office Action, claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal (as applied to claim 1 in its 35 U.S.C. §102(b) rejection) in view of Pletz. For the same reasons discussed above for claim 2, neither of the two references, taken alone or in combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

Section 7 of the Office Action notes that claims 19 and 20 are “analyzed in [a] similar matter” as claims 3 and 4. As mentioned above, the Office Action implies those claims are rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal in view of Pletz. For the same reasons discussed above for claim 2, neither of the two references, taken alone or in combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

In Section 7 of the Office Action, claims 21 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sabal (as applied to claim 1 in its 35 U.S.C. §102(b) rejection) in view of Hill. For the same reasons discussed above for claims 5 and 6, neither of the two references, taken alone or in combination, teaches or suggests all of the claim limitations, and therefore cannot support a *prima facie* case of obviousness.

### **III. Rejections Under 35 U.S.C. §112, Second Paragraph**

In Section 3 of the Office Action, claims 1-3, 5-7, and 18-22 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 3, 7, 19, and 21 have been amended to eliminate informalities in the claims, and meet the requirements of 35 U.S.C. §112.

Specifically, claim 1 has been amended to recite “a user qualification,” with subsequent references amended to recite “the required user qualification.” Claims 7 and 21 have been amended to correct similar informalities.

With respect to the rejection of claim 2, the claim does not contain the “at least one required user qualification” language cited in the Office Action.

Claims 3 and 19 have been amended to eliminate a claim limitation that was already recited their respective independent parent claims.

With respect to the rejection of claim 5, the Applicants respectfully point to claim 1 (“wherein the user qualification input signal includes *a unique user identifier*”) as antecedent basis for “the unique user identifier” recited in claim 5.

As the basis for indefiniteness has been eliminated, withdrawal of the rejections is respectfully solicited.

#### **IV. Conclusion**

Entry of these amendments is proper under 37 C.F.R. 1.116(b)(1), as they merely reflect wording changes without modification of the scope of the claims, and raise no issues that would require additional substantive examination. As no *prima facie* case of obviousness or anticipation can be established, and any basis for indefiniteness has been eliminated, the Applicants believe that the application is in condition for allowance. The Applicants respectfully request the Examiner’s favorable reconsideration of this application.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Stephen A. Becker  
Registration No. 26,527

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 SAB:MWE  
Facsimile: 202.756.8087  
**Date: July 12, 2006**

**Please recognize our Customer No. 20277  
as our correspondence address.**